

ESTTA Tracking number: **ESTTA603730**

Filing date: **05/12/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

### Opposers Information

Name	Valero Marketing and Supply Company
Granted to Date of previous extension	05/11/2014
Address	One Valero Way San Antonio, TX 78249-1616 UNITED STATES

Name	Valero Payment Services Company
Granted to Date of previous extension	05/11/2014
Address	One Valero Way San Antonio, TX 78249-1616 UNITED STATES

Attorney information	Stephen P. Meleen Pirkey Barber PLLC 600 Congress Ave., Suite 2120 Austin, TX 78701 UNITED STATES smeleen@pirkeybarber.com, tsmith@pirkeybarber.com, eolson@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512.322.5200
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### Applicant Information

Application No	85948619	Publication date	11/12/2013
Opposition Filing Date	05/12/2014	Opposition Period Ends	05/11/2014
Applicant	Valoro, LLC 2601 S. Biscayne Drive Miami, FL 33131 UNITED STATES		

### Goods/Services Affected by Opposition

Class 036. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Pre-paid purchase card services, namely, processing electronic payments through pre-paid cards

### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1314004	Application Date	08/01/1983
Registration Date	01/08/1985	Foreign Priority Date	NONE
Word Mark	VALERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1983/02/07 First Use In Commerce: 1983/02/07 Oil and Gas [ EXPLORATION, PRODUCTION, ] PROCESSING AND DISTRIBUTION SERVICES		


U.S. Registration No.	2656971	Application Date	06/02/2000
Registration Date	12/03/2002	Foreign Priority Date	NONE
Word Mark	VALERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2000/08/15 First Use In Commerce: 2000/08/15 convenience store services Class 037. First use: First Use: 2000/08/15 First Use In Commerce: 2000/08/15 Automobile Service Station services and car wash services		


U.S. Registration No.	2656973	Application Date	06/07/2000
Registration Date	12/03/2002	Foreign Priority Date	NONE
Word Mark	VALERO V		

Design Mark	
Description of Mark	Applicant is claiming color. The letter "V" and word "VALERO" consist of the color teal. The white portion of the line through the letter "V" consists of the color yellow and the black portion of the line consists of the color teal.
Goods/Services	Class 035. First use: First Use: 2000/08/15 First Use In Commerce: 2000/08/15 convenience store services Class 037. First use: First Use: 2000/08/15 First Use In Commerce: 2000/08/15 Automobile Service Station services and car wash services


U.S. Registration No.	2927757	Application Date	03/14/2003
Registration Date	02/22/2005	Foreign Priority Date	NONE
Word Mark	V VALERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 2000/08/15 First Use In Commerce: 2000/08/15 Gasoline and diesel fuel; lubricant base oil		

U.S. Registration No.	3688322	Application Date	08/25/2008
Registration Date	09/29/2009	Foreign Priority Date	NONE
Word Mark	V VALERO		

Design Mark	
Description of Mark	The mark consists of the letter "V" entwined with a curved line and the word "Valero".
Goods/Services	Class 040. First use: First Use: 2005/09/01 First Use In Commerce: 2005/09/01 Chemical processing services, namely, processing of petroleum feedstocks and chemicals, namely, mixed xylenes, benzene, toluene, propylene; petroleum refining; production of lubricant basestocks for others

U.S. Registration No.	2938790	Application Date	10/31/2002
Registration Date	04/05/2005	Foreign Priority Date	NONE
Word Mark	V VALERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/12/06 First Use In Commerce: 2002/12/06 Credit card services		

U.S. Registration No.	4216650	Application Date	10/05/2011
Registration Date	10/02/2012	Foreign Priority Date	NONE
Word Mark	VALERO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2002/12/06 First Use In Commerce: 2002/12/06 Credit card services

Attachments	76061505#TMSN.gif( bytes ) 76064760#TMSN.gif( bytes ) 78225654#TMSN.gif( bytes ) 77555225#TMSN.jpeg( bytes ) 78180635#TMSN.gif( bytes ) 85439607#TMSN.jpeg( bytes ) Notice of Opposition (037).pdf(31970 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/SPM/
Name	Stephen P. Meleen
Date	05/12/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VALERO MARKETING AND SUPPLY	§	In Re Serial No. 85/948,619
COMPANY and VALERO PAYMENT	§	Filed: June 3, 2013
SERVICES COMPANY,	§	Published: November 12, 2013
	§	
Opposers,	§	
v.	§	Mark: VALERO SYSTEMS
	§	
VALORO, LLC,	§	Opposition No. _____
	§	
Applicant.	§	

**NOTICE OF OPPOSITION**

Opposers Valero Marketing and Supply Company, a Delaware corporation, and Valero Payment Services Company, a Virginia Corporation (collectively, “Valero” or “Opposers”), both with a principal place of business at One Valero Place, San Antonio, Texas 78212, believe that they will be damaged by registration of the mark identified above, and hereby oppose same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposers assert that:

1. Since at least as early as 1979, Valero has continuously and extensively used the famous mark VALERO, alone and with design elements, (collectively, the “VALERO Marks”) in connection with the sale and promotion of a wide variety of products and services, including refining and marketing services, as well as credit card and gift card services.


2. The VALERO Marks are inherently distinctive, and serve to identify and indicate the source of Valero’s products and services to the consuming public, and to distinguish Valero’s products and services from those of others.




3. Valero has spent significant effort and millions of dollars advertising and promoting their VALERO Marks and the businesses operating under those marks, including its refining

operations, sales of various petroleum-based products, and the thousands of VALERO branded stations in the United States. Valero is the title sponsor of several nationally televised events, including the Valero Texas Open and the Valero Alamo Bowl.

4. Through Valero's long and continuous use of its VALERO Marks and its investment of time, effort, and money in promoting the goods and services offered under those marks, the VALERO Marks have become famous and well-known as identifying Valero's business and services. Furthermore, through Valero's extensive use and promotion of the VALERO Marks, Valero has developed valuable goodwill and strong rights in those marks.

5. Consistent with Valero's strong common-law rights, and in accordance with the provisions of federal law, Opposer Valero Marketing and Supply Company owns numerous valid, subsisting registrations (many of which are incontestable) for the VALERO Marks on the Principal Register of the United States Patent and Trademark Office ("PTO"), including the following, among others:

Mark	Registration No.	First Use Date	Goods & Services
VALERO	1,314,004	2/7/1983	Oil and gas processing and distribution services, in Class 42
VALERO	2,656,971	8/15/2000	Convenience store services, in Class 35 Automobile service station services and car wash services, in Class 37
	2,656,973	8/15/2000	Convenience store services, in Class 35 Automobile service station services and car wash services, in Class 37

Mark	Registration No.	First Use Date	Goods & Services
	2,927,757	8/15/2000	Gasoline and diesel fuel; lubricant base oil, in Class 4
	3,688,322	9/1/2005	Chemical processing services, namely, processing of petroleum feedstocks and chemicals, namely, mixed xylenes, benzene, toluene, propylene; petroleum refining; production of lubricant basestocks for others, in Class 42
	2,938,790	12/6/2002	Credit card services, in Class 36
VALERO	4,216,650	12/6/2002	Credit card services, in Class 36

6. Applicant Valero, LLC (“Applicant”) is a Florida limited liability company with a business address of 2601 S. Biscayne Drive, Penthouse No. 2, Miami, Florida 33131.

7. Applicant filed Application Serial No. 85/948,619 on June 3, 2013 under § 1(b) of the Lanham Act seeking to register the mark VALORO SYSTEMS for “Pre-paid purchase card services, namely, processing electronic payments through pre-paid cards” in International Class 36 (the “Application”).

8. The Application was published in the *Official Gazette* on November 12, 2013. This Notice of Opposition is timely based on extensions granted to Opposers.

9. Valero has priority based on its prior use and registration of its VALERO Marks in the United States.

10. Valero has not given Applicant permission or approval to use or register the mark VALORO SYSTEMS.



11. Applicant's mark VALORO SYSTEMS is confusingly similar to Opposer's VALERO Marks, and the services in Application are similar and related to the services for which Valero uses and has registered its VALERO Marks.

12. Applicant's mark VALORO SYSTEMS so resembles Valero's VALERO Marks as to be likely, when used on or in connection with the services identified in the Application, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the services Applicant intends to offer under the mark VALORO SYSTEMS are produced, sponsored, endorsed, or approved by Valero, or are in some way affiliated, connected, or associated with Valero. Valero would be damaged by registration of Applicant's mark VALORO SYSTEMS, which should be refused under 15 U.S.C. §§ 1052(d) and 1063.

13. Valero's VALERO Marks became famous prior to the date Applicant first used or applied to register the mark VALORO SYSTEMS.

14. Applicant's mark VALORO SYSTEMS would be likely to cause dilution by blurring or dilution by tarnishment of Valero's famous VALERO Marks, individually and collectively, and registration should be refused under 15 U.S.C. § 1125(c).

15. Registration of Applicant's mark VALORO SYSTEMS on the Principal Register would be inconsistent with Valero's rights under the aforementioned registrations and common law and would be damaging to Valero.

WHEREFORE, Opposers pray that Application Serial No. 85/948,619 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey

Barber PLLC, Account No. 50-3924/VLRO:037/SPM, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: May 12, 2014

/Stephen P. Meleen/  
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ATTORNEYS FOR OPPOSER

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail on May 12, 2014 on Applicant's attorney of record:

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